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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,096	12/02/2003	David K. Swanson	03-0242 (US01)	6001

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VISTA IP LAW GROUP LLP
12930 Saratoga Avenue
Suite D-2
Saratoga, CA 95070

EXAMINER

ROANE, AARÓN F

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,096	Applicant(s) SWANSON, DAVID K.	
	Examiner Aaron Roane	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12,28-35,37-40 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11,28, 30-35,37-40 and 43-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 9-11, 28, 30, 40, 43 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundback (US 4,736,749).

Regarding claim 7, 9-11, 28, 43 and 45-47, Lundback discloses a surgical apparatus comprising a tube (8) defining a proximal region and a distal region; a cup-shaped suction device (1 and 2 collectively) associated with the distal region of the tube and defining a distal surface (surface defined by 4), wherein part of the cup-shaped suction device is flexible (1), a tissue stimulation electrode (the tissue contacting side of 30) on the suction device distal surface; a source of stimulation energy (“electrical power source not shown” see col. 3, lines 3-12) connected to the stimulation electrode; and a suction source (see col. 3, lines 26-29), see col. 3 and 4 and figures 1-4.

Regarding claims 30 and 40, Lundback discloses an electrode size for the stimulation electrode that does not form a lesion of any kind at all, see col. 3 and 4 and figures 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundback (US 4,736,749) in view of Samson (US 6,185,442).

Regarding claims 8 and 44, Lundback discloses the claimed invention except for explicitly reciting that the suction tube is flexible. Samson disclose a suction electrode device comprising a suction (10) and an electrode (16) and teach the use of connecting the suction cup (10) to the pressure manipulator (14) via a bendable hose/tubing (15) in order to provide suction or vacuum pressure to the cup and to facilitate the comfort and versatile positioning during use, see col. 3 and 4 and figures 1-3. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Lundback, as taught by Samson, to use a bendable hose/tubing in order

Art Unit: 3739

to connect the suction cup to the pressure manipulator and to facilitate comfort and versatile positioning during use.

Claims 31-33 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundback (US 4,736,749) in view of Rau (US 4,685,466).

Regarding claims 31-33 and 37-39, Lundback discloses the claimed invention except for explicitly reciting that the stimulation electrode defines a perimeter of about 1.5 mm to 3mm, a thickness of about 0.01 mm and/or a diameter of about 0.5 mm to 1.0 mm. Rau discloses a stimulation suction electrode and teaches providing the electrode in a needle configuration (1) in order to provide fixation without electrode paste or jelly and to reduce skin resistance, see col. 3, lines 1-15, col. 4, lines 29-49 and figures 4-6.

The needle electrode of Rau provides all of the recited dimensions of the claimed invention. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Lundback, at taught by Rau, to provide the suction electrode with a needle electrode in order to provide fixation without electrode paste or jelly and to reduce skin resistance.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundback (US 4,736,749) in view of Colliou et al. (US 7,020,531).

Regarding claims 34 and 35, Lundback discloses the claimed invention except for explicitly reciting that the source of stimulation is configured to provide stimulation pulses that are about 1 msec in duration, 10 mA and two stimulation pulses per second. Colliou et al. disclose a stimulating suction electrode device and teach providing the device with a power source capable of delivering 1 mA to 30 mA of current, a pulse width of 0.1 msec to 500 msec and a pulse burst repetition period of about 100 μ sec to 20 msec in order to provide electrical stimulation, see col. 23, line 46 through col. 24, line 6 and figures 16A and 16B. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Lundback, as taught by Colliou et al., to provide the device with a power source capable of delivering 1 mA to 30 mA of current, a pulse width of 0.1 msec to 500 msec and a pulse burst repetition period of about 100 μ sec to 20 msec in order to provide electrical stimulation to tissue.

Response to Arguments

Applicant's arguments, see pages 6-11, filed 11/09/2006, with respect to the rejection of claims 7-11, 28, 30-35 and 37-40 under 35 U.S.C. § 112, first paragraph have been fully considered and are persuasive. The rejections of claims 7-11, 28, 30-35 and 37-40 under 35 U.S.C. § 112, first paragraph have been withdrawn.

Applicant's arguments filed 11/09/2007 with respect to the prior art rejections under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant

Art Unit: 3739

asserts that "Lundback '749 patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 7, 28 and 43," see page 13, lines 15 and 16. The examiner disagrees. Applicant has amended the 7, 28 and 43 to recite that the suction device defines a distal surface and that the stimulation element/means is on the distal surface of the suction device. As shown above and as evident from reviewing Lundback, Lundback discloses the newly claimed subject matter, wherein distal region/surface is the surface closes to patient and proximal is interpreted as starting from a distal point and moving away from the distal surface along the device. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

This action is made FINAL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3739

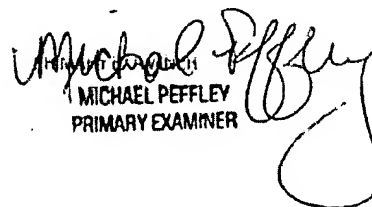
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane
February 5, 2007



MICHAEL PEFFLEY
PRIMARY EXAMINER